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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,967	01/09/2002	Andrew J. Bernoth	BLD920010010US1 (14550)	6679
7590 04/20/2006			EXAMINER	
Steven Fischman, Esq. Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			ADHAMI, MOHAMMAD SAJID	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,967

Applicant(s)

BERNETH, ANDREW J.

Examiner

Mohammad S. Adhami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

- Applicant's Amendment filed 2/1/2006 is acknowledged.
- Claim 14 has been amended
- Claims 16 and 17 have been added
- Claims 1-17 are pending
- Applicant's amendment to claim 10 has been acknowledged and the objection is withdrawn.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specifications do not adequately disclose how the method/system/device of claims 1,6, and 11 operate. The method/system/device of how a substitute filter is identified is not adequately disclosed.

The process of matching the pre-written filter files with the specifically written filter as claimed in claims 2,3,7,8,12 and 17 is not defined in the specifications, nor is a pre-defined test for carrying out this process.

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The predefined set of criteria in claims 4,9,14 and 17 is not supported in the specifications.

Searching for identified defined features as recited in claims 5,10, and 15 is not supported in the specifications.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hong (US App. 2004/0213233).

Re claims 1,6,11 and 13 (as best understood):

Hong discloses *providing a set of pre-written filters within one or more files* (Fig.9 ref.S905 where the routes in the network topology information are a “set of pre-written filters”).

Hong further discloses *providing a router filter written specifically for the router* (Fig.9 S905 where the routes in the previous routing table is a “filter written specifically”).

Hong further discloses *running a program on a computer to identify one or more pre-written filter files as a substitute for the specifically written filter* (Fig.9

ref.S905 where the routing table is reconstructed to replace the previous "written filter" and the network topology ("pre-written filter") is used to identify some of the routes on the topology to substitute).

Hong further discloses *loading one of the pre-written filters onto the router* (Fig.9 ref.S907).

Re claims 2-5,7-10,12,14, and 15 (as best understood):

Hong discloses *running a computer program to identify which one of the pre-written filters most closely matches the specifically written filter, according to a pre-defined test and criteria or features* (Abstract "The present invention performs BFRA (bounded Flooding Routing Algorithm) on a network topology information provided by a network management system to form a routing table" where the criteria (or feature) is the cost of the link and the cost is calculated and then used).

Re claim 16 (as best understood):

Hong discloses *loading both the pre-written and specifically written filter onto the router* (Fig.9 S905 and Fig.9 ref.S907 where both are stored).

Re claim 17 (as best understood):

Hong discloses *a group of individuals providing a plurality of router filters written specifically for the router* (Para.[0004] "it is needed to provide various yes distinguished services from other existing services to meet a user's expectations" where the specifically written filter is based on provided user expectations).

Hong further discloses *identifying for each specifically written filter a match in the pre-written filter* (Abstract "The present invention performs BFRA (bounded Flooding Routing Algorithm) on a network topology information provided by a network management system to form a routing table").

Hong further discloses *the pre-defined set of criteria being determined at the time the program is run and by a group of individuals* (Para.[0004] "it is needed to provide various yes distinguished services from other existing services to meet a user's expectations" where the user's expectations are used in the criteria).

Response to Arguments

5. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.
6. Applicant's arguments filed 2/1/2006 have been fully considered but they are not persuasive.
 - In the remarks on pgs 10 and 11, Applicant contends that the specifications enables the claims rejected under 112 1st paragraph.
 - The Examiner respectfully disagrees. An enablement rejection stands because "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, and concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated

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by the inventor of carrying out his invention." The specification fails to adequately disclose the above stated limitations.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sugai (US App. 2004/0085962) shows searching for a route and an input and output filter search.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad S. Adhami whose telephone number is (571)272-8615. The examiner can normally be reached on Monday-Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571)272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSA 4/16/2006


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